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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/644,031	08/20/2003	Sarah Davanzo	0525-0208P	5332

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EXAMINER

PETRIK, KARI KRISTEN

ART UNIT	PAPER NUMBER
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3743

DATE MAILED: 08/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/644,031	<b>Applicant(s)</b> DAVANZO, SARAH	
	<b>Examiner</b> Kari Petrik	<b>Art Unit</b> 3743	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 June 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.  
     4a) Of the above claim(s) 9-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Claims 9-12 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Applicant timely traversed the restriction (election) requirement in the reply filed on 6/2/2006.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 1 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. A claim reciting a portion of, or an attachment to, the human body contains non-statutory subject matter. 1077 OG 24 (April 21, 1987). "A claim directed to or including within its scope a human being will not be considered to be patentable subject matter under 35 U.S.C. 101". Accordingly, where a claim is directed to an apparatus "attached to" the human body or any part thereof, such a claim will be rejected under 35 U.S.C. 101, because the claim positively recites a part of the human body and therefore is directed to non-statutory subject matter.

Claim 1 recites an apparatus that is attached to a part of the human body. For example, in claim 1, Applicant recites "allows skin to which the adornment is adhered to breath". A claim reciting a portion of, or an attachment to, the human body contains non-statutory subject matter. Applicant can overcome this rejection by amending claim 1 to recite that the adornment is adapted to adhere to the skin.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 1, 2, 4, and 6-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Warren III et al (US Patent 5,782,638).

5. Regarding claim 1, Warren et al disclose an article of adornment comprising: a carrier layer (310) having a first adhesive on one side thereof (adhesively bonded to a dental substrate, column 14, lines 46-47), wherein the carrier layer is sterile and hypoallergenic (used in the mouth and column 8, lines 8-9), breathable (mesh material), and is capable of being applied to the skin. The article includes a removable covering layer (66) which covers the first adhesive when the adornment is not in use, and a metal layer (metal foil 301) connected to the carrier layer.

6. Regarding claim 2, the metal layer (301) includes gold, silver, platinum, or copper (column 3, lines 57-65).

7. Regarding claim 4, the metal layer is connected to the carrier layer using a second adhesive (column 14, lines 30-35).

8. Regarding claim 6, the carrier layer is of wire mesh material which is inherently resistant to water for use in the mouth.

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9. Regarding claim 7, based on the applicant's description in the specification of a synthetic medical skin being sterile, hypoallergenic, and breathable, the carrier layer Warren et al is a synthetic medical skin since it meets this criteria as shown in the rejection of claim 1.

10. Regarding claim 8, Warren et al disclose every structural element of claim 8, specifically that the carrier layer and metal layer are substantially the same size (Figure 11). The claim phrase "they have been cut after they have been connected to one another" is being treated as a product by process limitation. As set forth in MPEP 2113, product by process claims are NOT limited to the manipulations of the recited steps, only to the structure implied by the steps. Once a product appearing to be substantially the same or similar is found, a 35 U.S.C. 102/103 rejection may be made and the burden is shifted to applicant to show an unobvious difference. See MPEP 2113.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claim 3 and 5 rejected under 35 U.S.C. 103(a) as being unpatentable over Warren et al.

Warren et al substantially disclose the claimed invention as applied to claim 1 above.

Specifically, Warren discloses a gold leaf (gold foil or sheet) but does not disclose that the gold is 22ct or 24ct. In addition, Warren et al discloses the metal layer is connected to the carrier layer using any suitable adhesive, but does not disclose that the adhesive is Japan Gold Size.

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However, a thorough reading of the specification provides no criticality to the type of gold and adhesive used. At the time the invention was made, it would have been an obvious matter of design choice to one of ordinary skill in the art to have made the gold 24ct and the adhesive Japan Gold Size or any other selected materials, because Applicant has not disclosed that such a material provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Warren et al.'s article and Applicant's invention to perform equally well with either the adhesive used by Warren et al., or the claimed Japan Gold Size adhesive because both materials would perform the same function of adhesively connecting the metal and carrier layers together. Therefore, it would have been *prima facie* obvious to modify Warren et al. to obtain the invention as specified in the claims because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kari Petrik whose telephone number is 571-272-8057. The examiner can normally be reached on M-Th 7-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett can be reached on 571-272-4791. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Kari Petrik  
Examiner  
Art Unit 3743

KKP



Henry Bennett  
Supervisory Patent Examiner  
Group 3700